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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,494	09/21/2004	Terry M. Olkin	60468.300801	5493
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INTELLECTUAL PROPERTY LAW OFFICES 1901 S. BASCOM AVENUE, SUITE 660 CAMPBELL, CA 95008			EXAMINER CHAI, LONGBIT	
			ART UNIT	PAPER NUMBER
			2131	
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			05/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/711,494

Applicant(s)

OLKIN ET AL.

Examiner

Longbit Chai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/25/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for benefit of domestic priority under 35 U.S.C. 119(e) is acknowledged.

The application is filed on 9/21/2004 but has a U.S. provisional application number 60/481,407 filed on 9/22/2003.

Specification

2. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (SPEC: Page 3 Para [0011]). Applicant is required to delete / re-write the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Double Patenting

The nonstatutory provisional double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761

(CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 13 and 24 (& dependent claims 2 – 7, 9, 12, 14 – 18, 20, 23, 25 – 29, 31 and 34) are rejected under the judicially created doctrine of obviousness-type provisional double patenting as being unpatentable over claims 1, 11 and 20 (& dependent claims 2 – 4, 6, 8 – 10, 12, 13, 15, 17 – 19, 21, 23, 25 and 26) of U.S. Patent Copending Application No 10/711,495. Although the conflicting claims are not identical, they are not patentably distinct from each other because (a) the instant application is directed toward an authentication of a email and the copending application is directed toward an authentication of a URL link; however, the method of using a URL link to deliver an email is considered and recognized as obvious and well-known in the field at the time the invention was made – for example, a well-known content bearing WebDAV is a technology that stands for "Web Distributed Authoring and Versioning"; by using WebDAV, one just need to send the HTTP / URL link associated with the email instead of emailing the entire file (see the following Office action below: accessing an email

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message remotely between a client browser and an internet server), and (b) the "authenticity mark" as recited in the instant application is equivalent to the "originator identifier and encrypted data" as recited in Copending Application No 10/711,495.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. 102 that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3 – 9, 10, 13 – 20, 21, 24 – 29 – 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Garib (U.S. Patent 6,728,378).

As per claim 1, Garib teaches a **computer program, embodied on a computer readable storage medium, for assisting a user to determine whether an email comes from a purported originator** (Garib: Column 12 Line 60 – 63 and Column 16 Line 26 – 27: a claimed source of an email message is indeed a purported originator), **the computer program comprising:**

a code segment that determines with a computerized system whether the email includes an authenticity mark including an originator identifier and encrypted data (Garib: Column 12 Line 60 – 63, Column 6 Line 30 – 35, Column 16 Line 26 – 27 and Column 7 Line 5 – 12: both of the claimed source (considered as an originator identifier) and the encrypted message hash value embedded on the email message are qualified to serve as an authenticity mark for validating the integrity of email message);

a code segment that decrypts said encrypted data based on said originator identifier, into decrypted data (Garib: Column 15 Line 20 – 23: (a) a data element is encrypted at the sender by using its private key (b) the receiving entity knows the corresponding public key of the sender and (c) the receiving entity decrypts the data to ensure the validity of the received signature / encrypted hash value);

a code segment that presents to the user on a display unit (Garib: Column 12 Line 65 – 66):

whether the email includes said authenticity mark (Garib: Column 16 Line 23 – 29);

whether said encrypted data decrypts successfully; and information based on said authenticity mark and said decrypted data (Garib: Column 13 Line 51 – 59: the validation result is directed to the web browser to indicate / display the problem of the message).

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As per claim 13 and 24, Garib teaches a system for assisting a user to determine whether an email comes from a purported originator (Garib: Column 12 Line 60 – 63 and Column 16 Line 26 – 27: a claimed source of an email message is indeed a purported originator), the system comprising:

a computerized system having a display unit (Garib: Column 12 Line 65 – 66);

a logic in said computerized system that determines whether the email includes an authenticity mark including an originator identifier and encrypted data (Garib: Column 12 Line 60 – 63, Column 6 Line 30 – 35, Column 16 Line 26 – 27 and Column 7 Line 5 – 12: both of the claimed source (considered as an originator identifier) and the encrypted message hash value embedded on the email message are qualified to serve as an authenticity mark for validating the integrity of email message);

a logic in said computerized system that decrypts said encrypted data based on said originator identifier, into decrypted data (Garib: Column 15 Line 20 – 23: (a) a data element is encrypted at the sender by using its private key (b) the receiving entity knows the corresponding public key of the sender and (c) the receiving entity decrypts the data to ensure the validity of the received signature / encrypted hash value);

a logic in said computerized system that that presents to the user, on said display (Garib: Column 12 Line 65 – 66):

whether the email includes said authenticity mark (Garib: Column 16 Line 23 – 29);

whether said encrypted data decrypts successfully; and information based on said authenticity mark and said decrypted data (Garib: Column 13 Line 51 – 59: the

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validation result is directed to the web browser to indicate / display the problem of the message).

As per claim 3, 14 and 25, Garib teaches said code segment (that determines) runs as a service in said computerized system (Garib: Column 13 Line 32 – 35 and Column 12 Line 55 – 63: running as an internet HTTP web browser email account service including the authentications).

As per claim 4, 15 and 26, Garib teaches said code segment (that determines) includes a hypertext transport protocol (HTTP) server (Garib: Column 2 Line 32 – 38, Column 3 Line 4 – 15: world wide web email account access via a HTTP server and a client web browser).

As per claim 5, 16 and 27, Garib teaches said code segment (that determines) listens at a port in said computerized system for a request for hypertext markup language (HTML) content and extracts said authenticity mark from a uniform resource locator (URL) link requesting said HTML content (Garib: Column 2 Line 32 – 38: extracting email message formatted in HTML that includes a authenticity mark and can be accessed from www (i.e. a URL link) – Examiner notes any www/HTTP protocol must include a IP address (either a public or a private IP address) and an associated port (either a assigned / fixed or a dynamic port)).

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As per claim 6, 17 and 28, Garib teaches said code segment (that presents) further presents information to the user based on said originator identifier (Garib: Column 15 Line 20 – 23: the receiving entity uses the public key corresponding to the sender (i.e. originator identifier) to decrypt the data and presents the decrypted information to the user).

As per claim 7, 18 and 29, Garib teaches a code segment that matches said originator identifier to one of a plurality of registered originators maintained in a storage unit, to retrieve a decryption key associated with said originator identifier for use by said code segment that decrypts (Garib: Column 15 Line 20 – 23 / Line 39 – 41 and Column 16 Line 25 – 26: the receiving entity decrypts the email message and checks the received hash value by using the public key from stored memory to validate the claimed source).

As per claim 8, 19 and 30, Garib teaches said code segment (that determines) compares a checksum from said authenticity mark against contents of the email; and said code segment (that presents) further presents to the user information based on said checksum (Garib: Column 6 Line 30 – 35 and Column 13 Line 51 – 59: a hash / checksum value is generated the entire email content).

As per claim 9, 20 and 31, Garib teaches said code segment (that decrypts) employs a public key of said purported originator (Garib: Column 15 Line 20 – 23 / Line

39 – 41 and Column 16 Line 25 – 26: the receiving entity decrypts the email message and checks the received hash value by using the public key from stored memory to validate the claimed source).

As per claim 10, 21 and 32, Garib teaches said code segment (that decrypts) extracts at least one of a timestamp, a topic, and a user identifier from said encrypted data; and said code segment that presents further presents to the user information based on at least one of said timestamp, said topic, and said user identifier (Garib: Column 12 Line 55 – 59, Column 13 Line 51 – 59: the decrypted email message that must include a sender identifier / topic is directed to the web browser for display).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garib (U.S. Patent 6,728,378); and in view of Dunnion et al. (U.S. Patent 2002/0199119).

As per claim 2, Garib does not disclose expressly the computer program is digitally signed.

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Dunnion teaches the computer program is digitally signed (Dunnion: Para [0099]: the entire downloaded program can be digitally signed for security reason to ensure that the software downloaded is actually that provided by the supplier and has not been replaced or altered).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Dunnion within the system of Garib because (a) Garib teaches encrypting / decrypting an email message and to authenticate the requesting user with a signed data signature / hash value (Garib: Column 12 Line 60 – 63, Column 16 Line 26 – 27 and Column 7 Line 5 – 12), and (b) Dunnion teaches providing a method of a security services system where not only the data files and email traffic need to be secured but also the entire downloaded program can be digitally signed for security reason to ensure that the software downloaded is actually that provided by the supplier and has not been replaced or altered (Dunnion: Para [0005] and Para [0099]).

6. Claims 11, 22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garib (U.S. Patent 6,728,378), in view of Connery (U.S. Patent 6,606,709).

As per claim 11, 22 and 33, Garib does not disclose a code segment that compares said timestamp to preset timeliness criteria; and wherein said code segment that presents emphasizes said information based on said timestamp when said timeliness criteria are deviated from.

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Connery teaches a code segment that compares said timestamp to preset timeliness criteria; and wherein said code segment that presents emphasizes said information based on said timestamp when said timeliness criteria are deviated from (Connery: Column 8 Line 16 – 22: a timestamp test in a remote management system by using a timestamp field that carries the time when the management system sent message and the end system checks the timestamp to determine whether it is within a pre-specified time window D seconds in width, i.e., $\text{current time} - 0.5 * D \leq \text{timestamp} \leq \text{current time} + 0.5 * D$).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Connery within the system of Garib because (a) Garib teaches accessing an email message remotely between a client browser and an internet server; and encrypting / decrypting an email message and further authenticate the requesting user with a signed data signature / hash value (Garib: Column 12 Line 60 – 63, Column 16 Line 26 – 27 and Column 7 Line 5 – 12), and (b) Connery teaches providing an enhanced security mechanism in a remote management system by using a timestamp test that includes a timestamp field carrying the time when the management system sent message and the end system checks the timestamp to determine whether it is within a pre-specified time window (Connery: Column 8 Line 16 – 22).

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7. Claims 12, 23 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garib (U.S. Patent 6,728,378), and in view of Haitsuka et al. (U.S. Patent 6,766,369).

As per claim 12, 23 and 34, Garib does not disclose said code segment that presents employs a dialog box that only software running locally in said computerized system can provide, thereby avoiding confusion with a remotely generated browser window.

Haitsuka teaches said code segment that presents employs a dialog box that only software running locally in said computerized system can provide, thereby avoiding confusion with a remotely generated browser window (Haitsuka: Column 7 Line 35 – 37, Column 8 Line 44 – 47 and Column 10 Line 49 – 52: the display can have not only a browser window but also a client window; where the client window is generated / controlled by the local client application).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Haitsuka within the system of Garib because (a) Garib teaches accessing an email message remotely between a client browser and an internet server; and encrypting / decrypting an email message and further authenticate the requesting user with a signed data signature / hash value (Garib: Column 12 Line 60 – 63, Column 16 Line 26 – 27 and Column 7 Line 5 – 12), and (b) Haitsuka teaches providing a flexible mechanism with a display having not only a browser window but also a client window; where the client window is generated /

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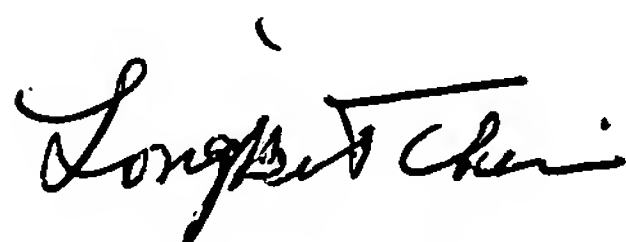
controlled by the local client application during an internet SSL communication session to indicate the connection status (including the authentication for a typical SSL connection) for the clarity purpose to avoid being confused with the display of browser window (Connery: Column 7 Line 35 – 37 and Column 10 Line 49 – 52 / Line 43 – 45).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Longbit Chai whose telephone number is 571-272-3788. The examiner can normally be reached on Monday-Friday 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R. Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Longbit Chai, Ph.D.
Patent Examiner
Art Unit 2131
5/16/2007